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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/763,248	01/26/2004	Shin Kanke	8024-1009	8015

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EXAMINER
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KOCH, GEORGE R

ART UNIT	PAPER NUMBER
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1734

DATE MAILED: 02/24/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>	
	10/763,248	KANKE, SHIN	
	<b>Examiner</b>	<b>Art Unit</b>	
	George R. Koch III	1734	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) ☒ Responsive to communication(s) filed on 22 December 2004.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) ☒ Claim(s) 1-10 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1, 2, 4, 5, 9 and 10 is/are rejected.
- 7) ☒ Claim(s) 3 and 6-8 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All    b) ☐ Some \*    c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date <u>3/31/2004</u> . | 6) <input type="checkbox"/> Other: _____  |

## **DETAILED ACTION**

### ***Election/Restrictions***

1. Applicant's election without traverse of group I, claims 1-10 in the reply filed on 12/22/2004 is acknowledged.

### ***Double Patenting***

2. A rejection based on double patenting of the "same invention" type finds its support in the language of 35 U.S.C. 101 which states that "whoever invents or discovers any new and useful process ... may obtain a patent therefor ..." (Emphasis added). Thus, the term "same invention," in this context, means an invention drawn to identical subject matter. See *Miller v. Eagle Mfg. Co.*, 151 U.S. 186 (1894); *In re Ockert*, 245 F.2d 467, 114 USPQ 330 (CCPA 1957); and *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970).

A statutory type (35 U.S.C. 101) double patenting rejection can be overcome by canceling or amending the conflicting claims so they are no longer coextensive in scope. The filing of a terminal disclaimer cannot overcome a double patenting rejection based upon 35 U.S.C. 101.

3. Claims 9-10 are provisionally rejected under 35 U.S.C. 101 as claiming the same invention as that of claims 51 and 54 of copending Application No. 10/219,812. This is a provisional double patenting rejection since the conflicting claims have not in fact been patented.

It is noted that the grammar and words are not "word-for-word". However, the limitations cover an identical scope. The analysis follows below.

As to the relationship between claim 51 of the '812 application and claim 9 of the instant application, the preambles are identical except that '812 recites "traveling band-shaped substrate", and the instant application calls for a "traveling base material".

However, the preamble does not modify the apparatus and thus provides no weight to the claimed apparatus (see MPEP 2111.02)

The upstream side coating section/device in both claims are structurally identical, and both form the lower layer.

The limitations as to the downstream side coating section/applying device are structurally identical and function identically to form the upper layer.

The limitations as to the undercoat liquid coating section/applying device are structurally identical and function to apply an undercoating liquid to the uncoated portion.

Similarly, as to the relationship between claim 54 of the '812 application and claim 10 of the instant application, the preambles are identical except that '812 recites "traveling band-shaped substrate", and the instant application calls for a "traveling base material". However, the preamble does not modify the apparatus and thus provides no weight to the claimed apparatus (see MPEP 2111.02).

The limitations as to the uncoated portion detecting section/detecting device are identical and function identically.

4. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double

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patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

5. Claims 9 and 10 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 51 and 54 of U.S. Patent No. 10/219,812. Although the conflicting claims are not identical, they are not patentably distinct from each other.

These claims have been rejected over statutory double patenting (see above). The only difference between the claims is the substrate in preamble and a few linguistic changes (coating section for applying device, i.e.)

As to the relationship between claim 51 of the '812 application and claim 9 of the instant application, the preambles are identical except that '812 recites "traveling band-shaped substrate", and the instant application calls for a "traveling base material". The band shaped substrate is considered to be either identical or a specific type of traveling base material.

The upstream side coating section/device in both claims are structurally identical, and both form the lower layer.

The limitations as to the downstream side coating section/applying device are structurally identical and function identically to form the upper layer.

The limitations as to the undercoat liquid coating section/applying device are structurally identical and function to apply an undercoating liquid to the uncoated portion.

The preamble and substrates of claim 51 of the '812 application is fully encompassed by the claim 9.

Similarly, as to the relationship between claim 54 of the '812 application and claim 10 of the instant application, the preambles are identical except that '812 recites "traveling band-shaped substrate", and the instant application calls for a "traveling base material". The band shaped substrate is considered to be either identical or a specific type of traveling base material.

The limitations as to the uncoated portion detecting section/detecting device are identical and function identically.

The preamble and substrates of claim 54 of the '812 application is fully encompassed by the claim 10.

### ***Claim Rejections - 35 USC § 102***

6. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

(f) he did not himself invent the subject matter sought to be patented.

(g)(1) during the course of an interference conducted under section 135 or section 291, another inventor involved therein establishes, to the extent permitted in section 104, that before such person's invention thereof the invention was made by such other inventor and not abandoned, suppressed, or concealed, or (2) before such person's invention thereof, the invention was made in this country by another inventor who had not abandoned, suppressed, or concealed it. In determining priority of invention under this subsection, there shall be considered not only the respective dates of conception

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and reduction to practice of the invention, but also the reasonable diligence of one who was first to conceive and last to reduce to practice, from a time prior to conception by the other.

7. Claims 9 and 10 directed to the same invention as that of claims 51 and 54 of commonly assigned 10/219,812. The issue of priority under 35 U.S.C. 102(g) and possibly 35 U.S.C. 102(f) of this single invention must be resolved.

Since the U.S. Patent and Trademark Office normally will not institute an interference between applications or a patent and an application of common ownership (see MPEP § 2302), the assignee is required to state which entity is the prior inventor of the conflicting subject matter. A terminal disclaimer has no effect in this situation since the basis for refusing more than one patent is priority of invention under 35 U.S.C. 102(f) or (g) and not an extension of monopoly.

Failure to comply with this requirement will result in a holding of abandonment of this application.

8. Claims 1, 2, 4, 5, 9, and 10 are rejected under 35 U.S.C. 102(e) as being anticipated by Kanke (US 10/219,812).

The applied reference has a common inventor with the instant application. Based upon the earlier effective U.S. filing date of the reference, it constitutes prior art under 35 U.S.C. 102(e). This rejection under 35 U.S.C. 102(e) might be overcome either by a showing under 37 CFR 1.132 that any invention disclosed but not claimed in the reference was derived from the inventor of this application and is thus not the invention "by another," or by an appropriate showing under 37 CFR 1.131.

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As to claim 9, Kanke discloses all of the limitations in claim 51. The band shaped substrate is considered to be either identical or a specific type of traveling base material.

The upstream side coating section/device in both claims are structurally identical, and both form the lower layer.

The limitations as to the downstream side coating section/applying device are structurally identical and function identically to form the upper layer.

The limitations as to the undercoat liquid coating section/applying device are structurally identical and function to apply an undercoating liquid to the uncoated portion.

As to claim 10, Kanke discloses all of the limitations in claim 54. The band shaped substrate is considered to be either identical or a specific type of traveling base material.

The limitations as to the uncoated portion detecting section/detecting device are identical and function identically.

As to claim 1, discloses all of the limitations in claim 51, Figures 36-42, and paragraphs 0587 to 0638. The band shaped substrate is considered to be either identical or a specific type of traveling base material.

The upstream side coating section/device in both claims are structurally identical, and both form the lower layer.



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The limitations as to the downstream side coating section/applying device are structurally identical and function identically to form the upper layer.

The limitations as to the undercoat liquid coating section/applying device are structurally identical and function to apply an undercoating liquid to the uncoated portion.

Furthermore, the undercoat liquid coating section is capable of and disclosed as being able to function as claimed in lines 14-24(see Figure 39 and paragraph 0593).

The liquid run out section is disclosed in Figure 39 and the coating is stopped when the liquid runs out as a result of item 606C, which lowers the undercoat liquid coating section.

As to claim 2, the stops of the supplying of liquid is discloses in paragraph 0611.

As to claim 4, Kanke discloses all of the limitations in claim 54. The band shaped substrate is considered to be either identical or a specific type of traveling base material.

The limitations as to the uncoated portion detecting section/detecting device are identical and function identically.

As to claims 5, Kanke discloses the signal output section (item 612), the calculating section (614), and control section (item 616) and the claimed functions (see Figure 40).

***Allowable Subject Matter***

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9. Claims 3 and 6-8 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to George R. Koch III whose telephone number is (571) 272-1230. The examiner can normally be reached on M-Th 10-7.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Christopher Fiorilla can be reached on (571) 272-1187. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



George R. Koch III  
Patent Examiner  
Art Unit 1734

GRK  
2/21/2005